

### **REMARKS/ARGUMENTS**

Claims 25-66 are pending in this application. Claims 25, 29, 33, 37, 41, 45, 49 and 53 are amended. All of the claim amendments are entirely supported by the application as originally filed, as discussed below. Thus, there is no issue of new matter. Additionally, claims 28, 36, 44 and 52 have been canceled without prejudice or disclaimer.

Entry of the claim amendments into the file of the present invention is respectfully requested. Upon such entry claims 25-27, 29-35, 37-43, 45-51 and 53-66, as amended, will be pending in the present application.

#### **Discussion of claim amendments**

Independent method claims 25, 33, 41 and 49 have each been amended with regard to their description of the active component of the agent(s) described therein. That is, in each case the claims have been amended to recite that the 'agent' (i.e., a sterilizing agent in claim 25; an antiseptic agent in claim 33; a disinfecting agent in claim 41; and an anti-parasitic agent in claim 49) recited therein comprises, as the only active component, at least one material selected from the group consisting of (C1-C20) dialkyl ketone peroxides and all of their possible isomers.

The recitation that the peroxides/isomers are the only active component of the various agents as recited in the claims is supported by the teachings found in the present application at p. 6, lines 14-16 and lines 28-30; on pps. 13-14 wherein the complete quantitative composition of Product 1 (NEOSTEX) and Product 2 (NEOSTEX PLUS) are given, which disclose as the (only) active ingredient, "a dialkyl ketone peroxide" (i.e., methyl ethyl ketone peroxide). A basis for the amendment is also found in all of the Examples 1-5 of the present application wherein the active ingredient is identified as, "a dialkyl ketone peroxide" (i.e., methyl ethyl ketone peroxide). In all of the examples set forth in the application, the compositions used are solutions of methyl ethyl ketone peroxide, which are prepared using no active ingredient other than a dialkyl ketone peroxide.

The other amendment made to the independent method claims is to limit the percentage by volume of the at least one material selected from the group consisting of (C1-C20) dialkyl ketone peroxides and all of their possible isomers to less than or equal to 5%. Support for this feature is

found, *inter alia*, in claims 28, 36, 44 and 52 filed with the present application. Those claims have, accordingly been canceled from the application without prejudice or disclaimer.

Furthermore, due to the above-noted cancellation of claims 28, 36, 44 and 52, claims 29, 37, 45 and 53 were also amended since they each depended, respectively, from one of the canceled claims. Thus, claims 29, 37, 45 and 52 are now amended such that they each depend upon a pending claim.

Per the discussion above, therefore, applicants respectfully submit that all of the amendments made to the claims in the present application are entirely supported by the application as originally filed and that there is, thus, no issue of new matter. Entry of the proposed claim amendments into the file of the present application is respectfully solicited.

#### **Restriction Requirement Under 35 U.S.C. §§121 and 372**

The Office Action alleges that the claims 25-66 are subject to restriction due to the fact that they constitute fourteen (14) separate inventions, i.e., designated as claim Groups I - XIV. The Action states that the various Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The Examiner acknowledges that a technical feature, i.e., (C1-C20) dialkyl ketone peroxides [and their isomers] is found in all of the claim groups, but alleges that the feature does not meet the necessary requirements for linking two or more claim groups together due to the disclosure contained in JP-6321711 and/or EP 0 775 439.

The applicant is advised, at the bottom of p. 4 of the Office Action, that the reply to the restriction requirement must include (i) an election of an invention to be examined even though the requirement be traversed, and (ii) an identification of the claims encompassing the elected invention. In response, therefore, to the requirement, applicants elect with traverse, the invention of Group I, claims 25-32.

Applicants respectfully traverse the restriction requirement to the extent that Group I (claims 25-32), Group II (claims 33-40), Group III (claims 41-48) and Group IV (claims 49-56) are indicated as constituting separate inventions. More particularly, applicants submit that the independent method claim from Groups I-IV (i.e., nos. 25, 33, 41 and 49) are now amended to recite a special

technical feature linking together all of the claims of Groups I-IV, which feature is neither taught nor even suggested by the cited prior art (please see the discussion following). The Examiner is, therefore, respectfully requested to withdraw the restriction requirement insofar as claim Groups I-IV are concerned and to examine all of the claims of those Groups (nos. 25-56) together in this application.

As indicated above, each of the independent claims 25, 33, 41 and 49, as amended, now recites *inter alia*: (1) that the agent comprises, as the only active component, at least one material selected from the group consisting of (C1-C20) dialkyl ketone peroxides and all of their possible isomers; and (2) that the active component is present in a percentage by volume of less than or equal to 5%.

Regarding the references cited in the present Office Action, i.e., JP-A-6 321 711 (hereinafter "D1") and EP-A-0 775 439 (hereinafter "D2"), applicants respectfully submit that, for the reasons set forth below the claims as amended are believed to distinguish the compositions used in the methods recited therein over both of the cited references. More particularly, D1 describes a germicide containing the combination of iron phthalocyanine and an organic peroxide. Amended claims 25, 33, 41 and 49 are distinguishable, however, over the disclosure contained in D1 in that the agents as recited in the subject claims are not a combination as disclosed in the subject reference. The reference does not teach, or even suggest, the agent as recited in applicants' claims.

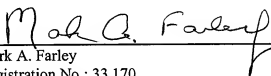
D2, on the other hand, discloses the use of a composition comprising from 12% to 70% of a dialkyl (C1-C6) ketone peroxide for the preservation and anatomical preservation of dead organic tissues of animal or human origin. Amended claims 25, 33, 41 and 49 are distinguishable over the disclosure contained in D2 due to their recitation that the concentration of the active agent is less than or equal to 5% (by volume). This feature is neither taught nor even suggested in D2.

In summary, therefore, applicants respectfully submit that claim Groups I - IV, due to the amendments to claims 25, 33, 41 and 49, are believed to all be linked together by a corresponding special technical feature not taught or suggested by D1 and/or D2. Thus, claims 25-56 are believed to relate to a single general inventive concept under PCT Rule 13.1. As such, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement inasmuch as it is

directed to claim Groups I - IV and to examine all of the claims of those Groups (nos. 25-56) together in the present application.

Respectfully submitted,

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY THROUGH  
THE PATENT AND TRADEMARK OFFICE  
EFS FILING SYSTEM ON January 29, 2009.

  
Mark A. Farley  
Registration No.: 33,170  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700

MAF:stb